

WENDEROTH et al
Serial No. 10/512,092
October 6, 2006



REMARKS

Favorable reconsideration and allowance of this application are requested.

The only issue remaining to be resolved in this application is the Examiner's rejection of claims 1-13 under 35 USC §103(a) as allegedly being "obvious" and hence unpatentable over Yoshimura in view of Peters et al. Applicants respectfully suggest however that a prima facie case of "obviousness" has not be proffered and, as such withdrawal of the rejection advanced under 35 USC §103(a) is in order.

Applicants specifically note that Peters discloses a cooling liquid for internal combustion engines which essentially consists of three major groups of components denoted by (A), (B) and (C), respectively. Group (A) concerns antifreeze compounds; group (B) concerns corrosion inhibitors and group (C) concerns cavitation inhibiting compounds. (See in this regard column 2, lines 35-65 of Peters.)

As can be clearly discerned from the specification of Peters, the entire thrust of the disclosure is focused on the provision of improved cavitation inhibitors (i.e., compounds of group (C)), while the antifreeze and corrosion inhibiting agents are those conventionally used in the art (see e.g., the description of the prior art in Peters at column 1, lines 45-51 and the subsequent focus on the improvement of cavitation inhibitors in most of the remainder of the Peters specification).

Consequently, contrary to the Examiner's understanding, Peters does *not* teach to use 0.1 to 3% of a sulfamide compound as a corrosion inhibitor but to use such compounds (belonging to group (C)) as a **cavitation inhibitor** which is present **in addition to** the conventional corrosion inhibitors of group (B) which are always present in the liquid disclosed by Peters.

Preferred corrosion inhibits of group (B) are mentioned in column 3, lines 53 to column 4, line 2 of Peters. Specifically, Peters teaches that "as a rule" a mixture of

those corrosion inhibitors has to be employed (column 4, lines 6-61 and the specific examples described in column 5).

Accordingly, in addition to the cavitation inhibiting sulfamide compounds of group (C), the cooling liquid disclosed by Peters will always comprise a mixture of ionic corrosion inhibitors of group (B). Consequently, there is no motivation for the skilled person to combine the teachings of Peters and Yoshimura because employing Peters' cooling fluid in the cooling circuit of Yoshimura which comprises deionization means would **effectively remove** the corrosion inhibitors from the cooling fluid. Thus, rather than provide an incentive to combine those teachings, Peters effectively teaches away from the present invention. At best, therefore, the rejection at issue here is based on a hindsight view of the applicants' invention which is per se impermissible.¹

The Federal Circuit has consistently and uniformly held that in order to be a *prima facie* case of "obviousness" under 35 USC §103(a), there must have been a suggestion that is clear from the prior art itself for a modification or combination to provide a claimed invention. For example, see the very clear decision in the case of *In re Vaeck*, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991), wherein the Court noted:

"Where claimed subject matter has been rejected as obvious in view of a combination of prior art references, a proper analysis under §103 requires, *inter alia*, consideration of two factors: (1) whether the prior art would have suggested to those of ordinary skill in the art that they should make the claimed composition or device, or carry out the claimed process; and (2) whether the prior art would also have revealed that in so making or carrying out, those of

¹ The Federal Circuit regards hindsight as an insidious and powerful phenomenon and is a tempting, but forbidden zone in the inquiry of addressing the statutory obviousness standard. See, e.g., *Panduit Corp. v. Dennison Mfg. Co.*, 227 USPQ 337 (Fed. Cir. 1985) and *Loctite Corp. v. Ultraseal Ltd.*, 228 USPQ 90, 98 (Fed. Cir. 1985).

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ordinary skill would have a reasonable expectation of success. See *In re Dow Chemical Co.*, 837 F.2d 469, 473, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988). Both the suggestion and the reasonable expectation of success must be found in the prior art, not in the applicant's disclosure. Id." (Emphasis added.)

It is axiomatic therefore that there must have been some suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to have selected the "references" and combined them in a way that would have produced the claimed invention.² As noted previously, no such suggestion, motivation and/or teaching exists in the references employed by the Examiner to support the rejection advanced against 35 USC §103(a). As such, withdrawal of such rejection is in order.

Early receipt of the Official Allowance Notice is awaited.

Respectfully submitted,

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² See, e.g., *Heidelberger, Druckmaschinen AG v. Hantscho Commercial Prods., Inc.*, 30 USPQ2d 1377, 1379 (Fed. Cir. 1994) ("When the patented invention is made by combining known components to achieve a new system, the prior art must provide a suggestion or motivation to make such a combination."); *Northern Telecom Inc. v. Datapoint Corp.*, 15 USPQ2d 1321, 1323 (Fed. Cir. 1990) (It is insufficient that the prior art disclosed the components of the patented device, either separately or used in other combinations; there must be some teaching, suggestion, or incentive to make the combination made by the inventor."); and *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 5 USPQ 1434, 1438 (Fed. Cir. 1988).